



not adequately disclose the necessary apparatus to perform the claimed method.” (Detailed Office Action, page 5, item 5.)

The application discloses and describes a central server 10 and user computers 14 that are interconnected on a communication network 16. The application discloses and describes that the central server 10 includes an online (real time) server 10b, an offline server 10b, and a statistic queries server 10c. The application discloses and describes that the online server 10b includes a communication manager 10a, chat query handlers 10a4, user info handlers 10a7, as well as other apparatus. Descriptions for the other apparatus are also disclosed. Similarly, the user computers 14 are disclosed and describes as including communication manager 48, peer-to-peer communication manager 56, browser tracking process 42, as well as other structure. Additionally, the application discloses and described processes for implementing the claimed methods. (See Specification and Figures 1-6d.) Applicants submit that the application discloses apparatus and processes sufficient to enable a person of ordinary skill in the art at the time of the invention to practice the invention without undue experimentation.

Applicants respectfully submit that “the state of the art, the level of one of ordinary skill, and the level of predictability in the art” are factors to be considered in determining whether there is any undue experimentation. (MPEP § 2164.01(a), *citing In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).) Applicants submit that the state of the art and its predictability at the time of the invention by Applicants were sufficient to allow a person of ordinary skill in the art at the time of the invention to practice the claimed invention without undue experimentation.

Serial No: 09/477,511

Response to Office Action dated March 31, 2004

{W:\02559\100F420US2\00193274.DOC 100F420US2\00193274.DOC 100F420US2\00193274.DOC 100F420US2\00193274.DOC }



**Rejection Under 35 U.S.C. § 102**

Claims 1-3 and 5-7 and 9-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by MacNaughton.

Amended claim 1 now recites the steps of “matching the preferred parameter criteria from among the parameter criteria received from the second and the other users to locate chat partners; transmitting, to the first user, identities of users matching the preferred parameter criteria” and “selecting the visibility of the semi-public chat session such that only users located in the matching step, having the preferred predetermined received from the first user, can view and participate in the semi-public chat session.” Support for these features is disclosed in the Specification at page 46, line 19 through page 47, line 6 — *e.g.*, “responding to a request from user computer 14 to locate suitable ‘chat partners’,” “receive from user computer 14 a set of preferred parameters,” and “transmit the result to user computer 14.” Additionally, the Specification at page 25, lines 3-7 discloses “if the chat session is semi-public, then only users with predetermined user profiles that correspond in some way to the participants in the chat session may view or participate in the semi-public chat session.”

Applicants submit that MacNaughton does not disclose that “only users located in the matching step, having the preferred predetermined received from the first user, can view and participate in the semi-public chat session.” MacNaughton does not disclose a semi-public chat session, where a first user selects preferred parameter criteria which will permit a chat session to

be selectively visible to only those other users which match the preferred parameter criteria supplied by the first user. Applicants submit that MacNaughton does not disclose each and every element of amended claim 1. Therefore, Applicants submit that MacNaughton does not anticipate claim 1.

Independent claims 5, 9-11, 13 and 14 have been amended in a like manner to recite the features now recited in amended claim 1. Applicants submit that claims 5, 9-11, 13 and 14 are patentable over MacNaughton for reasons similar to those discussed for claim 1.

Claims 2-3 depend from claim 1, and Applicants submit that claims 2-3 are patentable over MacNaughton for at least the same reasons as claim 1. Claims 6-8 depend from claim 5, and Applicants submit that claims 6-8 are patentable over MacNaughton for at least the same reasons as claim 5. Claim 12 depends from claim 11, and Applicants submit that claim 12 is patentable over MacNaughton for at least the same reasons as claim 11.

Withdrawal and reconsideration of the rejection is requested.

### **Rejection Under 35 U.S.C. § 103**

Claims 4 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton in view of the Examiner's statement of what was known by a person of ordinary skill in the art at the time of the invention.

The Examiner acknowledges that MacNaughton fails to “express [that] personal data include[s] a mood data.” The Examiner combines MacNaughton and the Examiner’s Official Notice and states that “using mood data as personal indication data was well known in the art.” (Detailed Office Action (mailed November 21, 2002), page 7, item 13.) Applicants submit that the combination of MacNaughton and the Examiner’s Official Notice neither discloses nor suggests, singly or in combination, the features recited in amended claims 1 and 5 of a selectively visible semi-public chat session based on preferred parameter criteria received from a first user, as discussed above.

Claim 4 depends from claim 1 and claim 8 depends from claim 5. Applicants submit that claims 4 and 8 are patentable over the combination of MacNaughton and the Examiner's Official Notice for at least the same reasons as their respective base claims.

**Withdrawal and reconsideration of the rejection is requested.**

## CONCLUSION

Each and every point raised in the Office Action dated March 31, 2004 has been addressed on the basis of the above remarks. In view of the foregoing it is believed that claims 1-15 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: June 1, 2004

Respectfully submitted,

By 

Richard J. Katz

Registration No.: 47,698

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 753-6237 (Fax)

Attorneys/Agents For Applicants